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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,579	08/25/2003	Toshiyuki Takabayashi	03500/HG	4092
1933	7590	02/02/2006	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 Fifth Avenue 16TH Floor NEW YORK, NY 10001-7708			BERMAN, SUSAN W	
		ART UNIT	PAPER NUMBER	
		1711		

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/648,579

**Applicant(s)**

TAKABAYASHI, TOSHIYUKI

**Examiner**

Susan W. Berman

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a)  The period for reply expires 3 months from the mailing date of the final rejection.  
 b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a)  They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b)  They raise the issue of new matter (see NOTE below);  
 (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-5, 7 and 12.

Claim(s) withdrawn from consideration: 8-11.

AFFIDAVIT OR OTHER EVIDENCE

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached pages.

12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.

13.  Other: See PTOL Form 892 attached.

*Interview Summary 01/03/06 attached*

*SB*  
 Susan W Berman  
 Primary Examiner  
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***Terminal Disclaimer***

The terminal disclaimer filed on 01/05/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application No. 10/647,170 has been reviewed and is accepted. The terminal disclaimer has been recorded. The provisional rejection of the instant claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 10/647,170 [PrePublication 20040052967] is withdrawn.

***Claim Rejections - 35 USC § 102***

The instant claim recitation “maximum bond distance...0.1688-0.1750 nm” is considered to include all bond distances less than the maximum 0.1688 nm. If applicant intends to limit the bond distance to a distance between 0.1688 nm and 0.1750 nm, the claim language should so state. The sulfonium compounds disclosed by Ohkawa et al (6,368,769) having a S<sup>+</sup> to C bond length less than 0.1688 nm are encompassed by the instant claim language. Therefore, the rejection of claims 1-3, 7 and 12 under 35 USC 102(b) set forth in the Final Rejection mailed 10/19/2005 is maintained.

***Claim Rejections - 35 USC § 103 & Declarations under 37 CFR 1.132***

The evidence for unexpected results presented in the Declaration under 37 CFR 1.132 filed 06/09/2005 and the Supplemental Declaration under 37 CFR 1.132 filed 12/14/2005 has been reconsidered. The evidence in view of the scope of the instant claims has been reconsidered. Upon reconsideration, the data presented in the Declarations filed 06/09/2005 and 12/14/2005 is unpersuasive of unexpected results for the following reasons.

The sulfonium salts disclosed by Ohkawa et al are species corresponding to applicant’s Formula (II) in instant claim 1. The sulfonium salts tested in the Declaration filed 06/05 as being representative of

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the instant invention are salts of Formula (I) in instant claim 1. Applicant compared Examples 3 and 4 disclosed by Ohkawa et al with Examples comprising Compound 7 or Compound 5 in Ink Set 2 of the instant invention. Compounds 5 and 7 are species of Formula (I) in instant claim 1. Thus the comparative data presented fails to compare Examples disclosed by Ohkawa et al to Examples from the instant claims which are the closest to the prior art disclosure. Ohkawa et al disclose sulfonium salts in the Synthesis Examples that are species of Formula (II) set forth in instant claim 1, not of Formula (I) in instant claim 1. In addition, the data is not commensurate in scope with the instant claims because the photopolymerizable compositions employed to show unexpected results comprise a colorant, an oxetane compound, an epoxy compound, an acid increasing agent, a thermal base generator in addition to the photoacid generator. There is no evidence of record to show unexpected results for compositions comprising only a “photopolymerizable monomer” or comprising photopolymerizable monomers other than epoxy and oxetane monomer mixtures. Therefore, the rejection of claims 1-5, 7 and 12 under 35 USC 103(a) set forth in the Final Rejection mailed 10/19/2005 is maintained.

Upon filing an Appeal the status of claim 6 will be reconsidered. Claim 6 recites the viscosity of an ink jet ink composition and is not included in the rejections of record. With respect to the rejections maintained, Ohkawa et al do not teach the low viscosities set forth. However, It is considered to be within the ordinary skill in the art to adjust the viscosity of a known composition for a particular application, such as ink jet printing. See Mantell et al (5,641,346) or Ushirogouchi et al (6,959,986).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W. Berman whose telephone number is 571 272 1067. The examiner can normally be reached on M-F 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SB  
1/30/06

*Susan Berman*

Susan W Berman  
Primary Examiner  
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